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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,322	09/17/2003	Nubar Ozbalik	EI-7610	4163

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NEW MARKET SERVICES CORPORATION  
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RICHMOND, VA 23219

EXAMINER
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SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/664,322

**Applicant(s)**

OZBALIK ET AL.

**Examiner**

Callie E. Shosho

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,9-14,16,17,20-24,26,27,30-34,36,37,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9-14,16,17,20-24,26,27,30-34,36,37,40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/13/06, 3/6/06, &amp; 4/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 5/2/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

**Information Disclosure Statement**

2. It is noted that Tagliamonte et al. (U.S. 6,528,458) has been stricken from the IDS filed 4/14/06 as redundant given that the reference was already cited on the PTO-892 filed with the office action mailed 1/27/06.

**Claim Rejections - 35 USC § 102**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 5-6, 9-14, 16-17, 20-21, 32-34, 36-37, and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dasai (U.S. 5,064,546) taken in view of the evidence given in Watts et al. (U.S. 6,660,695).

The rejection is adequately set forth in paragraph 9 of the office action mailed 1/27/06 and is incorporated here by reference.

**Claim Rejections - 35 USC § 103**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 22-24, 26-27, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasai (U.S. 5,064,546).

The rejection is adequately set forth in paragraph 18 of the office action mailed 1/27/06 and is incorporated here by reference.

7. Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagliamonte et al. (U.S. 6,528,458).

Tagliamonte et al. disclose method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising dialkyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, and friction modifier, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in clutch transmission to lubricate the slipping start-up clutch. Example 1 of Tagliamonte et al. discloses combining major amount of base oil and additive composition wherein it is calculated that the power transmitting fluid comprises 85% base oil, 0.09% dibutyl hydrogen phosphite, 0.42% antioxidant, 3.4% dispersant, and 0.04% antifoaming agent. Further, based on the amount of additives alone, it is calculated that the additive composition comprises approximately 0.6% dibutyl phosphite, 2.8%

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antioxidant, 22.3% dispersant, and 0.04% antifoaming agent (col.1, lines 6-10, col.2, lines 5-7, col.9, lines 30-34, col.11, lines 27-27 and 60, and example 1).

The difference between Tagliamonte et al. and the present claimed invention is the requirement in the claims of additive composition comprising dioleyl hydrogen phosphite.

Example 1 of Tagliamonte et al. disclose the use of additive composition comprising dibutyl hydrogen phosphite, antioxidant, anti-foaming agent, and dispersant. However, there is no explicit disclosure of composition comprising dioleyl hydrogen phosphite, antioxidant, anti-foaming agent, and dispersant as presently claimed.

However, col.6, lines 33-54 of Tagliamonte et al. disclose the use of fatty phosphite friction modifier of the formula  $(RO)_2PHO$  wherein each R group has 8 to 24 carbon atoms and explicitly disclose that in one embodiment each R group is formed from oleyl group.

Further, given that Tagliamonte et al. disclose power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would intrinsically possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would intrinsically be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use dioleyl hydrogen phosphite as the friction modifier in the power transmitting fluid of Tagliamonte et al. and thereby arrive at the claimed invention.

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8. Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (U.S. 4,231,757) in view of Tagliamonte et al. (U.S. 6,528,458) and Watts et al. (U.S. 6,660,695).

Davis discloses method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising dialkyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, and diluent oil, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently contain slipping torque converter and wet clutch. Attention is called to Example A in col. 22 of Davis that discloses combining major amount of base oil and additives to form power transmitting fluid comprising the base oil, 1% dispersant, 0.2% antioxidant, 0.077% dialkyl hydrogen phosphite, and 0.02% anti-foaming agent. It is calculated based on the amounts of additives alone, that the additive composition comprises approximately 8.6% dispersant, 1.7% antioxidant, 0.66% dialkyl hydrogen phosphite, and 0.17% anti-foaming agent (col.1, lines 9-16, col.18, lines 51, 57-58, and 63-66, and example A).

The difference between Davis and the present claimed invention is the requirement in the claims of diolel hydrogen phosphite.

Davis broadly discloses the use of dialkyl hydrogen phosphite.

Tagliamonte et al., which is drawn to power transmitting fluid, disclose the use of fatty phosphite friction modifier of the formula  $(RO)_2PHO$  wherein each R group has 8 to 24 carbon

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atoms and explicitly disclose that in one embodiment each R group is formed from oleyl group.

it is disclosed that the phosphite is used as a friction modifier (col.6, lines 33-54).

Given that Davis in combination with Tagliamonte et al. discloses power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is clear that the composition would intrinsically possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would intrinsically be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the motivation for using dioleoyl hydrogen phosphite disclosed by Tagliamonte et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use dioleoyl hydrogen phosphite in the power transmitting fluid of Davis in order to produce fluid with desired friction properties, and thereby arrive at the claimed invention.

9. Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fyfe et al. (U.S. 2004/0129603) in view of Nelson et al. (U.S. 6,884,855) and Watts et al. (U.S. 6,660,695).

Fyfe et al. disclose method of formulating a power transmitting fluid comprising providing a major amount of base oil, providing a minor amount of an additive composition comprising anti-wear compound such as dibutyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, detergent, anti-rust additive, and friction modifier, and combining the base oil with the additive composition. It is disclosed that the power



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transmitting fluid comprises 0.01-6% anti-wear compound, 0.01-5% antioxidant, 0.1-20% dispersant, and 0.001-3% anti-foaming agent. It is disclosed that the power transmitting fluid is used in automatic transmission, which is well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently contain slipping torque converter and wet clutch (paragraphs 80, 136, 157-158, 163, 166, 172-173, 178, 191, 207, 219-220, and Table 3).

The difference between Fyfe et al. and the present claimed invention is the requirement in the claims of dioleoyl hydrogen phosphite as well as the amounts of dispersant, antioxidant, dioleoyl hydrogen phosphite, and defoaming agent in the additive composition.

Fyfe et al. disclose the use of dibutyl hydrogen phosphite.

There is no explicit disclosure in Fyfe et al. of the amounts of dispersant, antioxidant, dibutyl hydrogen phosphite, and defoaming agent in the additive composition. However, Fyfe et al. does disclose that the power transmitting fluid comprises 0.01-6% dibutyl hydrogen phosphite, 0.01-5% antioxidant, 0.1-20% dispersant, and 0.001-3% anti-foaming agent. Based on these amounts, it is calculated that the additives comprise approximately 0.03-84% dibutyl phosphite, 0.03-83% antioxidant, 0.7-99% dispersant, and 0.003-75% anti-foaming agent in Fyfe et al.

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a *prima facie* case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Further, while Fyfe et al. disclose the use of dibutyl hydrogen phosphite, there is no disclosure of dioleoyl hydrogen phosphite as now required in all present claims.



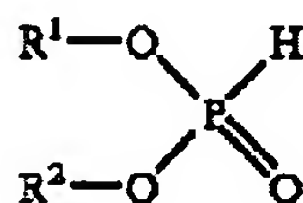
Nelson et al., which is drawn to power transmitting fluid, disclose the use of dioleoyl hydrogen phosphite in order to improve antiwear and extreme pressure properties. Nelson et al. also disclose the equivalence and interchangeability of using dibutyl hydrogen phosphite disclosed by Fyfe et al. with using dioleoyl hydrogen phosphite as presently claimed (col.11, lines 19-20 and 30-31).

Given that Fyfe et al. in combination with Nelson et al. disclose power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would intrinsically possess enhanced wear protection and enhanced anti-shudder durability as presently claimed and that the power transmitting fluid would intrinsically be suitable for use in a belt, chain, or disk-type continuously variable transmission as presently claimed.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to (i) use dioleoyl hydrogen phosphite in the power transmitting fluid of Fyfe et al. in order to produce fluid with good antiwear and pressure properties and (ii) absent evidence to the contrary, to choose any amount of dibutyl hydrogen phosphite, antioxidant, dispersant, and defoaming agent, including those presently claimed, in Fyfe et al. in order to control the properties of the power transmitting fluid, and thereby arrive at the claimed invention.

10. Claims 20-23, 25-27, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumiejski et al. (U.S. 2005/0014656) in view of Dasai (U.S. 5,064,546) and Watts et al. (U.S. 6,660,695).

Sumiejski et al. disclose power transmitting fluid possessing improved wear resistance and anti-shudder properties wherein the power transmitting fluid is formulated by providing a major amount of base oil, providing a minor amount of an additive composition comprising hydrocarbyl phosphite of the formula:



wherein R<sup>1</sup> and R<sup>2</sup> are each hydrocarbyl groups including linear or branched alkyl group having 8 to 40 carbon atoms, antioxidant, dispersant, and defoaming agent, and combining the base oil with the additive composition. It is disclosed that the power transmitting fluid comprises 78-99.9% base oil, 0.1-5% hydrocarbyl phosphite, and 0-10% additives including dispersant, detergent, antioxidant, corrosion inhibitor, foam inhibitor and friction modifier. Attention is called to example 1 that discloses power transmitting fluid comprising base oil, 0.2% dialkyl C16-C18 hydrogen phosphite, 2.25% dispersant, 2.2% antioxidant, and 55 ppm anti-foaming agent. Based on the additives alone, it is calculated that the additive composition comprises approximately 2.2% dialkyl hydrogen phosphite, 25.6% dispersant, 25% antioxidant, and 0.06% anti-foaming agent. It is further disclosed that the power transmitting fluid is used in automatic transmissions, which are well known, as evidenced by Watts et al. (col.2, lines 13-18), to inherently containing slipping torque converter and wet clutch (paragraphs 1, 34-38, 79, 85, 94-97, 101, 1101-11, 130-131, and 158).

The difference between Sumiejski et al. and the present claimed invention is the requirement in the claims of dioleoyl hydrogen phosphite.

Dasai, which is drawn to power transmitting fluid, disclose the use of dioleoyl hydrogen phosphite as a friction modifier. Dasai also discloses the equivalence and interchangeability of using dilauryl hydrogen phosphite as disclosed by Sumiejski et al. with using dioleoyl hydrogen phosphite as presently claimed (col.3, line 50-col.4, line 8).

Given that Sumiejski discloses power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is clear that the power transmitting fluid would inherently be suitable for use in a belt, chain, or disk-type continuously variable transmission.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use dioleoyl hydrogen phosphite in the power transmitting fluid of Sumiejski et al. in order to produce fluid with desired friction properties, and thereby arrive at the claimed invention.

#### **Response to Arguments**

11. Applicants' arguments regarding EP 113199 and EP 646639 have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

12. Applicants' arguments filed 5/2/06 have been fully considered but, with the exception of arguments relating to EP 113199 and EP 646639, they are not persuasive.

Specifically, applicants argue that Tagliamonte, Fyfe et al., Davis et al., Sumiejski et al., and Dasai et al. are no longer relevant references against the present claims under 35 USC 102 in light of the amendments to the present claims.

With respect to Tagliamonte, Fyfe et al., Davis et al., and Sumiejski et al., it is agreed that these references are no longer applicable against the present claims under 35 USC 102. However, in light of applicants amendment, Tagliamonte, Fyfe et al., Davis et al., and Sumiejski et al. are each now applied against the present claims under 35 USC 103 as set forth in paragraphs 7-10 above.

With respect to Dasai et al., applicants argue that while Dasai et al. teach that dioleoyl hydrogen phosphate can be used, Dasai et al. do not utilize the dioleoyl hydrogen phosphate in any formulations with other claimed compounds in the examples and tables of the reference. However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims”, *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole clearly discloses the use of dioleoyl hydrogen phosphite (col.4, line 9).

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tomaro (U.S. 6,503,872), similar to Dasai (U.S. 5,064,546), discloses lubricant comprising base oil, antioxidant, dioleoyl hydrogen phosphite, dispersant and ant-foaming agent.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

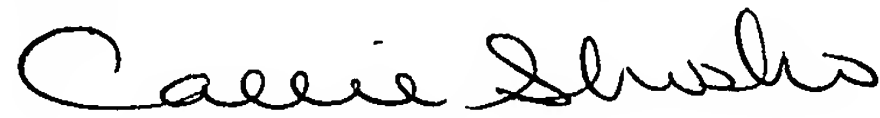
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
7/13/06